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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/534,471	03/24/2000	Kenneth A. Parulski	80724PRC	3331

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PATENT LEGAL STAFF
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EXAMINER

O CONNOR, GERALD J

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 01/13/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/534,471 Examiner O'Connor	Applicant(s) Parulski Art Unit 3627	
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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on July 29, 2002 (Amdt "A") and October 24, 2002 (Amdt "B").
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.
- 4) Claim(s) 1-6 and 8-19 is/are pending in the application.
- 4a) Of the above, claim(s) none is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-6 and 8-19 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some* c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) Other: _____

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DETAILED ACTION

Preliminary Remarks

1. This Office action has been prepared in response to the amendment and arguments filed by applicant on July 29, 2002 (Paper N^o 4) and the amendment filed by applicant on October 24, 2002 (Paper N^o 6), in response to the Office action of April 23, 2002 (Paper N^o 3).

2. The amendment of claims 1 and 9 by applicant in Paper N^o 4 is hereby acknowledged.

3. The cancellation of claim 7 by applicant in Paper N^o 6 is hereby acknowledged.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 17-19 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kitagawa et al. (US 5,819,126).

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Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-6 and 8-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art described in the specification, in view of Kitagawa et al. (US 5,819,126).

The admitted prior art, as described by applicant, clearly anticipates all of the substantive elements of the instant invention with regard to a method of sales of customized products, except for disclosing that the particular customized product being offered for sale and selected/created by the customer in the manner of computer systems at dell.com is a camera system being sold for one time use (i.e. "leased"). The admitted prior art further allows that "sales" of such one-time-use (i.e. "leased") cameras is a conventional method in the art, for non-customized cameras.

Kitagawa et al. disclose a camera system which clearly anticipates all of the apparatus features of the instant camera system, as applied above under 35 U.S.C. 102(b), but Kitagawa et al. do not disclose a method of selling customized versions of their camera using a website, nor do they disclose "leasing" their camera (i.e. "selling" it for a one-time use or other limited use).

However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the known method of customized product sales of computers using a

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website such as dell.com, so as to sell camera systems instead of computer systems, such as the camera system of Kitagawa et al., with the customer selecting particular features in accordance with the known computer sales method, and selling the camera system for a one-time use (i.e. "leased"), as is conventional in the art for non-customized camera systems, so as to increase the profits of a company selling one-time-use cameras by reaching a wider market via the Internet, while satisfying a range of specific market niches by means of customization.

Regarding claims 12-15, storing a customer's photos as digital files and delivering those digital files by means of CD-R, e-mail, or allowing a customer to download the files from a specified Internet location, are all well known, hence, obvious method steps to follow in the art of photographic services. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have further modified the method of sales so as to convert the customer's photos into digital files and deliver those digital files by means of CD-R, e-mail, or allowing a customer to download the files from a specified Internet location, since so doing could be performed by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results, merely as a matter of design choice, in order to improve sales even further by offering customers even more photo options.

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Response to Arguments

8. Applicant's arguments filed July 29, 2002 have been fully considered, but they are not persuasive.
9. Regarding the argument with respect to apparatus claim 17, that Kitagawa et al. fail to disclose providing a service identifier or a service provider account, and further fail to disclose specifying services to be provided by the service provider, the nature and use of the particular data being written into the device is considered merely an intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In any event, the apparatus of Kitagawa et al. indeed includes the particular claimed usage of providing a service identifier account and services to be provided by the service provider, as the apparatus of Kitagawa et al. pertains to the Advanced Photo System (APS) photography system, which system Kitagawa et al. disclose inherently includes identification numbers of the user and services to be provided, such as the user specifying, for each individual exposure on the roll of film, the desired size and aspect ratio for printing by the service provider. See, in particular, column 1, lines 1-58.

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10. In response to applicant's argument with respect to the obviousness rejection, that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teaching of Dell is merely for the selling of customized products over the Internet. The selling of non-customized cameras over the Internet is admitted to be conventional, and Kitagawa et al. disclose a customized camera having the same particular features and usage as that of the instant invention. Therefore, the motivation to combine is simply to sell cameras such as that of Kitagawa et al. in the customized online manner of Dell rather than in the conventional online manner.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to the disclosure.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of

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the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, Jerry O'Connor, whose telephone number is (703) 305-1525, and whose facsimile number is (703) 746-3976.

GJOC

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ROBERT P. OLSZEWSKI
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January 10, 2003